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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,205	11/18/2003	Mitchell Chapin Green	06975-452001	2248
26171 7590 08/09/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SALOMON, PHENUEL S	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,205

Applicant(s)

GREEN ET AL.

Examiner

Phenuel S. Salomon

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,14,16,18-21 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8,14,16,18-21 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment file on, May 25, 2007.
2. Claims 1, 3, 14, and 20-21 are amended, claims 2, 4, 9-13, 15, 17, and 22-26 are cancelled, claims 27-36 are newly added and claims 1, 3, 5-8, 14, 16, 18-21 and 27-36 are pending.
3. The previous objections to the specification and the drawings have been withdrawn in view of the amendment.
4. The rejection of claims 1-3, 9-10, 14-16 and 22-23 under 35 U.S.C. 102 (e) as being anticipated by Doss (US 2003/0046296 A1) has been withdrawn as necessitated by the amendment and claims cancellation.
5. The rejection of claims 11-13 and 24-26 under 35 U.S.C. 103 (a) as being anticipated by Doss (US 2003/0046296 A1) in view of Malik (US 2003/0219104 A1) has been withdrawn as the claims have been cancelled.

Claim Objections

6. Claims 20-21 are objected to because they are dependent on cancelled claim 17. These claims are being examined as dependent on claim 1.
Appropriate correction is required

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on 5/21/07 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 35-36 are method that refers back to Claim 29, which is a graphical user interface claim. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since claim 29 is a graphical user interface comprising two steps and claims 35-36 make it unclear as to what statutory subject matter is being claimed.

See Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990)

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 5-8, 27, 29-30 and 33-34 are rejected under 35 U.S.C. 101 because of non-functional descriptive material. The claimed invention is drawn to a list of items that are shown on a window (a contacts list and an icon) which are just descriptive material, but there are non-functional. Furthermore, the “graphical user interface” appears to be claiming computer program per se. Since it is not embodied on a computer readable medium , claiming computer program alone would be non-statutory.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Becker (US 2002/0130904 A1).

Claim 1 Doss discloses a graphical user interface that enables a user to access an instant messaging service, the graphical user interface comprising:

a window that includes:

a contacts list listing one or more other users of the instant messaging service selected by the user as significant to the user, the contacts list being configured to make online presence information for the other users perceivable to the user (p.1, para [0007] and [0008]); and

an icon associated with one of the other listed users (fig. 7) but does not explicitly disclose indicating that an email message has been exchanged between the user and the other user. However Becker discloses an email message notification after it has been sent” (p.11, para [0088]). Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to include Becker's email exchange notification in Doss. One would have been motivated to do so in order to facilitate data sharing as required while the user is being notified of such data transferred.

(Examiner note: It's inherent that a user should be part of another user list to identify his/her status and therefore, communications can occur between them.)

Claim 3: Doss and Becker disclose a graphical user interface as in claim 1 above, Doss further discloses the icon is displayed only if the user selects a representation of the other user in the list of other users (p.2, para. [0018]).

Claim 14: Doss discloses a method comprising:

providing an instant messaging system to a user (Page 1, Par. [0007]) (Examiner note: The use of a network or internet makes computer service inherent);

displaying to the user of the instant messaging service a graphical user interface that enables the user to access the instant messaging service, the graphical user interface comprising a window that includes a contacts list listing one or more other users of the instant messaging service selected by the user as significant to the user (p.1, para. [0008]), the contacts list being configured to make online presence information for the other users perceivable to the user and to enable the user to initiate communication sessions with the other users (p.1, para. [0007]); and

displaying an icon associated with one of the other users (fig. 7) but does not explicitly disclose the contacts list indicating that an email message has been exchanged between the user and the other user. However Becker discloses a " (p.11, para [0088]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the email exchange notification in Doss. One would have been motivated to do so in order to facilitate data sharing as required while the user is being notified of such data transferred.

Claim 16: Doss and Becker disclose a method as in claim 14 above, Doss further discloses comprising displaying the icon when the user scrolls over a representation of the other user in the contacts list of other users (p. 2, para. [0018] lines 9-12).

13. Claims 5-8 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Becker (US 2002/0130904 A1) and in further view of Widger (US 2005/0117733).

Claims 5 and 18: Doss and Becker disclose a graphical user interface as in claims 1 and 14 above, but does not explicitly disclose an icon indicates that an unread email message has been exchanged between the user and the other user. However, Widger discloses in "Fig. 7, an example of a system tray showing an icon that identifies to the user that new messages have been received" (p. 6, par.[0045]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a new message icon in Doss. One would have been motivated to do so in order to assure notification and fast access to email message.

Claims 6 and 19: Doss and Becker disclose a graphical user interface and a method as in claims 1 and 14 above, but does not explicitly disclose icon indicating the number of unread email messages that have been exchanged between the user and the other user. However, Widger discloses "a message notification icon...with associated number of messages received" (Examiner note: Since the message icon displayed the number of messages received; therefore the number of unread email message is inherent.) (p. 5, par.[0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify the user in Doss about the number of messages received. One would have

been motivated to add that feature in order to enable the user to quickly and efficiently handle received email messages.

Claims 7 and 20: Doss and Becker disclose a graphical user interface and a method as in claims 5 and 14 above, but does not explicitly disclose an icon, when selected by the user opens or activates an application to read the email message. However, Widger discloses “a message notification portion when clicking on the icon accesses the associated application” (p. 5, par. [0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include that feature into Doss. One would have been motivated to add that feature in order to quickly access and review one’s email content without interruption.

Claims 8 and 21: Doss and Becker disclose a graphical user interface and a method as in claims 6 and 14 above, but does not explicitly disclose an icon, when selected by the user, opens or activates an application listing multiple email messages exchanged between the user and the other user. However, Widger discloses “a message notification icon...with associated number of messages received” (p. 5, par. [0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a new message icon that shows listing of multiple e-mail messages in Doss. One would have been motivated to do so in order to better organize the email message inbox.

14. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Becker (US 2002/0130904 A1) and in further view of Jenkins (US 6,950,502 B1).

Claim 27: Doss and Becker disclose the graphical user interface as in claim 1 above, wherein the window further comprises a calendar associated with a particular one of the other listed users indicating that a

calendar event has been scheduled that involves both the user and the particular other user and enabling determination by the user that the calendar event involves the particular other user (p. 2, para [0016]) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user], but do not explicitly disclose a calendar icon. However, Jenkins discloses a calendar icon with associated messages (col. 14, lines 42-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a calendar icon in Doss. One would have been motivated to do so in order to constantly remind the user about the scheduled event or meeting while performing a task, thus without any inconvenience of opening a separate application to obtain the same information.

Claim 28: Doss and Becker disclose the method as in claim 14 above further comprising a particular one of the other users in the contacts list indicating that an event has been scheduled that involves both the user and the particular other user and enabling determination by the user that the calendar event involves the particular other user (p. 2, para [0016]) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user], but do not explicitly disclose displaying an icon associated with a calendar event. However, Jenkins discloses a calendar icon with associated messages (col. 14, lines 42-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a calendar icon in Doss. One would have been motivated to do so in order to constantly remind the user about the scheduled event or meeting while performing a task, thus without any inconvenience of opening a separate application to obtain the same information.

15. Claims 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Jenkins (US 6,950,502 B1).

Claim 29: Doss discloses a graphical user interface that enables a user to access an instant messaging service, the graphical user interface comprising:
a window that includes:

a contacts list listing one or more other users of the instant messaging service selected by the user as significant to the user, the contacts list being configured to make online presence information for the other users perceivable to the user(p.1, para [0007] and [0008]); and

one of the other listed users indicating that an event has been scheduled that involves both the user and the other user and enabling determination by the user that the calendar event involves the other user (p.2, para [0015], [0016]) and (fig. 7) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user], but does not explicitly disclose an icon associated with a calendar event. However, Jenkins discloses a calendar icon with associated messages (col. 14, lines 42-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a calendar icon in Doss. One would have been motivated to do so in order to constantly remind the user about the scheduled event or meeting while performing a task, thus without any inconvenience of opening a separate application to obtain the same information.

Claim 30: Doss discloses the graphical user interface as in claim 29 above, but does not explicitly disclose the icon, when selected by the user, opens or activates an application to view the calendar event. However, Jenkins discloses a calendar icon with associated messages (col. 14, lines 42-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a calendar icon in Doss. One would have been motivated to do so in order to constantly remind

the user about the scheduled event or meeting while performing a task, thus without any inconvenience of opening a separate application to obtain the same information.

Claim 31: Doss discloses a method comprising:

providing an instant messaging system to a user (Page 1, Par. [0007]);

displaying to the user of the instant messaging service a graphical user interface that enables the user to access the instant messaging service, the graphical user interface comprising a window that includes a contacts list listing one or more other users of the instant messaging service selected by the user as significant to the user (p.1, para. [0008]), the contacts list being configured to make online presence information for the other users perceivable to the user and to enable the user to initiate communication sessions with the other users (p.1, para. [0007]); and

displaying an icon associated with one of the other users in the contacts list indicating that an event has been scheduled that involves both the user and the other user and enabling determination by the user that the calendar event involves the other user (p. 2, para [0016]) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user], but does not explicitly disclose displaying an icon associated with a calendar event. However, Jenkins discloses a calendar icon with associated messages (col. 14, lines 42-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a calendar icon in Doss. One would have been motivated to do so in order to constantly remind the user about the scheduled event or meeting while performing a task, thus without any inconvenience of opening a separate application to obtain the same information.

Claim 32: Doss and Jenkins disclose the method as in claim 31 above, Jenkins further discloses

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comprising displaying the calendar event in response to selection of the icon by the user (col. 14, lines 42-44).

Claim 33: Doss and Jenkins disclose the graphical user interface as in claim 29 above, Doss further discloses the icon indicates that the calendar event has been scheduled by the other user (p. 2, para [0016]) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user. Therefore, the other user is also part of the event scheduling].

Claim 34: Doss and Jenkins disclose the graphical user interface as in claim 29 above, Doss further discloses the icon indicates that the calendar event has been scheduled by the user (p. 2, para [0015] and [0016]).

Claim 35: Doss and Jenkins disclose the method as in claim 29 above, Doss further discloses the icon indicates that the calendar event has been scheduled by the other user (p. 2, para [0016]) [designating a backup person means that an arrangement or agreement was made between both users, the user has to know the availability of the particular other user. Therefore, the other user is also part of the event scheduling].

Claim 36. Doss and Jenkins disclose the method as in claim 29 above, Doss further discloses the icon indicates that the calendar event has been scheduled by the user (p. 2, para [0015] and [0016]).

Response to Arguments

16. Applicant's arguments filed on 05/25/2007 have been fully considered but they are not persuasive but rather moot in view of the new ground(s) of rejection.

Conclusion

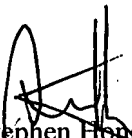
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
a. Daniell et al. (US 2004/0054735A1) discloses multi-system instant messaging (IM).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571) 270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00 P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272 4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS
7/27/2007


Stephen Hong
Supervisory Primary Examiner